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T.H.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Yoshiwara et al

Serial No.: 09/818,851

Group Art Unit: 3635

Filed: March 28, 2001

For: Manufacture and Use of Earthquake Resistant  
Construction Blocks

Examiner: Amiri, Nahid

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**RESPONSE**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Sir:

This is in response to the FINAL Office Action dated 9/24/2003.

It is noted that the office action mailed 09/24/2003 has been made final even though a new grounds of rejection has been made (35 USC 112, second paragraph). The office action is further confused by the fact that, under the "Disposition of Claims," box 4 has been checked, indicating claims 1-19 to be pending, and box 5 has also been checked, indicating claims 1-19 to all be allowable. Your applicant has no desire to delay prosecution of this application further, but is making a complete response in an effort to clarify and reduce the issues for appeal.

**Office Action**

Claims 1 and 14-16 are rejected under 35 USC 112, second paragraph.

Claims 1, 8-13 and 19 are rejected under 35 USC 103(a).

## Response

### 35 USC 112 Rejection

Claims 1 and 14-16 have been rejected under 35 USC 112, second paragraph. It is difficult to understand any reason why a mechanic in the art would not understand the claims.

Claim 1 has been rejected under 35 USC 112, second paragraph, as being indefinite.

Claim 1 is considered indefinite by the Examiner because the preamble is for an earthquake resistant structure when only a single construction block is being claimed. By implication, the single block is not a structure and, is not earthquake resistant, and thus it is inoperative to resist earthquakes.

This rejection is not logical or legally supportable. If a single block does not meet the criteria of the preamble, being earthquake resistant, then how/why can two or more blocks in combination be earthquake resistant? It is the structure of each individual block that yields their individual and their collective earthquake resistance, such as their use in a bridge. A structure by definition is simply something made of parts fitted or joined together, and the way in which constituent parts are fitted or joined together, or arranged to give something its peculiar nature or character. A single block meets this definition.

Since no inoperative rejection has been made, and the block structure is, in reality, the crux of the invention, it must be assumed that the real perceived problem is claim breadth.

In the “Field of the Invention” it states that construction blocks are manufactured independently or in place. The block construction is detailed on pages 8 and 9, for example, with the repeated construction of individual blocks detailed on page 14.

It is firmly established law that an applicant can claim his invention as broadly as permitted by the prior art. The fact that a claim is broad does not necessarily justify a rejection on the ground that the claim is vague and indefinite or incomplete. In non-chemical cases, a claim may, in general, be drawn as broadly as permitted by the prior art. MPEP 706.03(d). In a mechanical case, broad claims may be supported by a specific embodiment and an inventor need not limit his claims to precisely what he has found will work to ease the path of a would be infringer. Beale vs Schuman, 212 USPQ 291 (BdA&I 1980).

It is an applicant’s prerogative to define his invention and the Examiner has not stated a definition or interpretation of the preamble that is in conflict with or otherwise renders the preamble or claims indefinite. It is the inventor applying for a patent who is permitted to be his own lexicographer as long as the meaning of an expression is made reasonably clear and its use is consistent within the patent disclosure. Ellipse Corp. v Ford Motor Co., 171 USPQ 513, (CA 7 1971).

Claim 1 is in compliance with the requirements of 35 USC 112 second paragraph.

Claims 14-16 have been rejected, under 35 USC 112, second paragraph, because it appears both a method of forming the “blocks” and a method of making a structure using the “block” is being claimed.

As noted, pages 8 and 9, for example, address block formation and page 14 addresses the formation of an arch. The formation of the arch includes providing a mold and using it to form a block with the aggregate, mortar and removing or separating the mold and block (claimed in claim 13). Additional blocks are formed in contacting relationship by either forming them in place or separately (claims 14-16). The Examiner has misconstrued the claiming of sub-combinations with claiming different categories or classes of inventions. The claims 13-16 are all directed to the steps for forming construction blocks. The fact that more than one block can be formed is irrelevant. It is to be noted that the preamble for all the claims is for the “process of forming construction blocks” (emphasis added), i.e. more than one.

The rejection fails because it does not meet adjudicated principles for 35 USC 112, second paragraph, claim rejections. Insofar as the rejection is understood:

1) Even if a claim is considered to be drafted in unconventional narrative form, the metes and bounds of the claims are defined with a reasonable degree of particularity, and are thus not indefinite under the second paragraph of 35 USC 112. In re Miller, 169 USPQ 597 (CCPA 1971), In re Borkowski, 164 USPQ 642 (CCPA 1970).

2) Even if claims are considered to be drawn in functional or narrative form, the issue is whether they set forth reasonable boundaries upon which patent protection is sought. In re Barr, 170 USPQ 330 (CCPA 1971), In re Swinehart, 169 USPQ 226 (CCPA 1971).

3) Claim limitations which cover two or more statutory classes of invention under 35 USC 101 are not precluded by the statute. There is no need to speculate as to the meaning of the claims. In re Steele et al, 134 USPQ 296.

4) The fact that a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment. In re Rasmussen, 211 USPQ 323 (CCPA 1981).

5) An applicant is entitled to claim a sub-combination. Where a claim to a combination includes one or more element that is by itself non-obvious, the entire claim meets the unobviousness test. In re Hirao, 190 USPQ 15 (CCPA 1976). A claim need not recite each and every element needed for practical utilization of claimed subject matter. Sub-combination claims drawn to only one aspect or combination of elements that has utility separate and apart from other aspects of the invention are appropriate. Carl Zeiss Stifling v Renshaw, 20 USPQ 2d 1994 (CCPA 1976).

The Board has stated in Ex parte Adrianus P.M.M. Moelands, 3 USPQ 2d 1474 (BdApp&I 1987)

This statutory provision merely requires that the claims set forth and circumscribe a particular area with a reasonable degree of precision and particularity. The definiteness of the claim language employed must not be analyzed in a vacuum, but always in light of the teachings of

the prior art and of the particular application disclosure as it would be interpreted by one having ordinary skill in the particular art. In re Moore 169 USPQ 236 (CCPA 1971).

The examiner should allow claims which define the patentable novelty with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. (MPEP § 706.03(d)).

There has been no showing that the mechanic in the art would not understand the meets and bounds of the claims or that the claims are not definite within the authoritative guidelines for rejections under 35 USC 112, second paragraph. There is nothing prohibiting one claimed article from being used with an article that is the same or a process for making one article from being used to make a second article that is a duplicate of the first.

The claims are in compliance with 35 USC 112 second paragraph.

In view of the above reasoning and law, it is requested that the 35 USC 112, second paragraph, rejection be withdrawn to reduce the issues for appeal.

#### 35 USC 103 Rejection

Claims 1, 8-13 and 19 are rejected under 35 USC 103(a) as being unpatentable over Kirkpatrick.

The rejection under 35 USC 103 is traversed in that the Examiner has failed to comply with old and well-established patent law.

When it comes to reference interpretation, the examiner's "opinion" is of little worth. The reference teaches, or does not teach, the claimed structure. Either the reference must teach the structure claimed or the claim should be allowable. This concept is firmly established and consistently followed by the courts.

An earthquake resistant structure is being claimed. Whether a single block or a combination of blocks, the structure remains the same. A single block composed of individual components is as capable of earthquake resistance as two or more blocks, if not more so. An applicant is entitled to claim his invention as broadly as permitted by the prior art. The examiner's distinguishing a single block from two blocks does not diminish the patentability of a new, novel and unobvious single block per se.

A. The patent to Kirkpatrick addresses a non-analogous art.

Claim 1 is drawn to "an earthquake resistant structure." The patent to Kirkpatrick (U.S. 1,487,578) is to a "building block, which is provided with a crushed rock veneer face or the like" (lines 10-12). The patent to Kirkpatrick is directed to a non-analogous art and is thus not legally available as a reference against the present claims. An earthquake resistant structure is not analogous to a decorative block having an aesthetic, crushed-rock veneer face.

When a reference is neither from applicant's field of endeavor nor reasonably related to the particular problem with which applicant is involved, the reference is a non-analogous art. In re Wood, 202 USPQ 171 (CCPA 1979).

B. The structure taught by Kirkpatrick is different from the structure claimed.

Claim 1 requires a "construction block ... having... an upper surface and a lower surface and side surfaces" and "aggregate pieces ... adjacent to said lower surface" and "said aggregate pieces extending from and between said construction block sides".

Kirkpatrick teaches: A building block "provided with a crushed rock veneer face" (lines 9-16). "The crushed rock or the like is placed in a form and the crevices between the rocks are filled with smaller rocks after which the cement is poured into the form." (lines 43-46). The reinforcement elements 16 and 17 are embedded in the cement with spaced eyes or loops 18 projecting from the rear face of the block to accommodate tie wires 19 (lines 46-56) that hold the blocks in position upon the wall as shown (lines 59-63).

The rocks 10 of Kirkpatrick are not in the lower surface, they are on the front face. The rocks of Kirkpatrick do not extend between the side surfaces. The sides of the blocks abut each other but the rocks adjacent the front faces of the blocks do not. There are no horizontal forces placed on the blocks other than those created by the wires 19 that hold the rear face of the blocks onto the wall 20. The positioning of the rocks precludes horizontal forces. The vertical forces are restricted to those created by gravity and they are transferred only through the cement in the



blocks. The rocks in the face are far removed from both horizontal and vertical forces. If anything else is involved with forces, it is the reinforcing elements 16 and 17.

1. The stones of Kirkpatrick are not on the lower surface, they are on a vertical face. This is clear in that:

- a) Kirkpatrick states the crushed rocks form a veneer face. They are on the front face.
- b) The drawings show that they are on the front face.

2. The stones of Kirkpatrick do not extend between the sides of the block.

- a) The disclosure precludes the rocks from extending from one side to the other.
- b) The arrangement of the blocks on a wall demonstrates that the rocks do not extend to the sides.

In the claims the “eyes” are stated to “project beyond one face of the block.” It is to be noted: “When the block is removed from the form, it requires no washing or any further work, and it is ready to be placed upon the wall 20 as shown in Figure 1.” (Lines 56-59). As is clear from Fig. 1 and Fig. 2, the crushed rocks of the veneer face 10 of the blocks do not extend longitudinally to the ends of the block and do not extend vertically to a height or depth that is more than  $\frac{1}{2}$  the depth of the chamfer on the ends of the block face. There is thus a clear, incontestable teaching within the four corners of the patent to Kirkpatrick that the form used to manufacture the block has about a 45 degree chamfer that extends into the form to a height twice the distance the crushed rocks are to be poured into it extending along the front face of the block.

It is the applicant who defines the invention and terms used. The Examiner is not at liberty to redefine the invention or interpret the invention to be in conflict with those set forth by the applicant. The Examiner has opined that the chamfer of Kirkpatrick is in fact sides. Kirkpatrick states that the rocks are in the front face of the block.

The chamfers are not the sides, as can be clearly seen in Fig. 2, they are a part of the aesthetic front face of the block. The sides of Kirkpatrick abut and when assembled are recessed within the wall with the faces, including the chamfer and stone surface, protruding outward from the wall.

A reference which is not directed to the same purpose and does not have the same inventive concept as claimed under consideration cannot be fairly applied in rejecting such claims. In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965). All limitations, including the preamble, must be considered. In re Duva, 156 USPQ 90 (CCPA 1967). Another approach to the same issue is that the prior art must address and provide the inventor's answer to the particular problem confronting the inventor. In re Winslow, 151 USPQ 48 (CCPA 1966).

To use Kirkpatrick to reject claim 1 requires modifications to Kirkpatrick that are not taught within the four corners of the patent. The rocks must be moved to the lower surface and the rocks must extend beyond the chamfer. A modification of the prior art not taught by the reference cannot be relied on under 35 USC 102 or 103. Deering Milliken Research Corp. v. Beaunit Corp., 182 USPQ 421 (DCWNC 1974).

An article of manufacture is being claimed, i.e. an earthquake resistant block. The aggregate is on the lower surface. The “aggregate” of Kirkpatrick is not on a lower surface as set forth above. Further evidence that belies the Examiner’s opinion that Kirkpatrick has aggregate on the lower surface is the fact that Fig. 1 is a longitudinal sectional view while Fig. 2 is a vertical sectional view taken through a wall. As can be seen in Fig. 2, only concrete is present on the upper surface and lower surface with the aggregate front face of the block protruding outward from the wall.

The prior art as a whole must be considered. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Hedges et al, 228 USPQ 685 (CAFC 1986). In re Wesslau, 147 USPQ 391 (CCPA

C. The structure of Kirkpatrick cannot function as the claimed structure does.

Claim 1 requires: “said aggregate pieces held in contact with each other by mortar so that impact and stress forces applied to said construction block are transferred directly from one aggregate piece to another throughout said construction block.”

Kirkpatrick teaches the block is “provided with reinforcement elements to afford the block maximum strength” with “tie wire for holding the blocks in position” (lines 12-16). The invention

resides “in the construction, combination, and arrangement of parts” (lines 21-23). The structure of Kirkpatrick precludes any forces from being applied to the rocks.

All limitations of a claim must be considered in determining the claimed subject matter. It is error to ignore specific limitations distinguishing over the reference. Ex parte Murph and Burford, 217 USPQ 479 (BdApp 1982); In re Boe, 184 USPQ 38 (CCPA 1974); In re Wilder, 166 USPQ 545 (CCPA 1970). Functional language must be considered. Ex parte Bylund, 217 USPQ 492 (BdApp 1981).

The Examiner has rejected claims 8-13 and 19 as it would be “within the general skill of a worker in the art to select a known material on the basis of suitability for the intended use as matter of obvious design choice.” (Emphasis added.) The Examiner is making this statement based on his misinterpretation of the claims and the invention.

It is the patent to Kirkpatrick that is directed to a design and aesthetic structure, not the present invention.

The present invention is clearly drawn to the concept that the materials being used have, in the past, i.e. rocks, been considered by mechanics in the art to be unacceptable. The fact is that the claims 8-13 teach the direct opposite from the teaching of Kirkpatrick. The statement rock or the like is precisely the materials your applicant is trying to avoid.

Attention is directed to page 1, Field of the invention, Page 3, Summary, lines 10-16, of the specification as one of the several places where the state of the art is addressed, stating the low quality materials are not considered acceptable. It is incumbent upon the examiner to show by independent evidence and established facts that this is false.

There has been no showing by the Examiner that the previously unacceptable materials in the art are acceptable for the intended use, earthquake resistance.

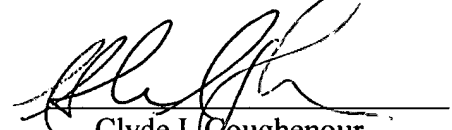
#### SUMMARY

The claims are definite and structurally and functionally define over the patent to Kirkpatrick. The only association between the claimed structure and that of Kirkpatrick are those modifications made by the Examiner having no basis in fact or evidence of record.

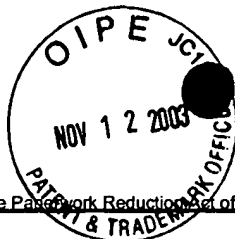
## CONCLUSION

The claims are definite and patentable over the patent to Kirkpatrick and in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

  
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/818,851	
	Filing Date	March 28, 2001	
	First Named Inventor	Susumu Yoshiwara	
	Art Unit	3635	
	Examiner Name	Amiri, Nahid	
Total Number of Pages in This Submission	15	Attorney Docket Number	

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